REMARKS/ARGUMENTS

Amended Claim 11 is supported by the description at paragraph [0044] of the specification.

Amended Claim 15 has been rewritten as an independent claim, including all the recitations of the base claim and any intervening claim.

Claim 30 has been cancelled.

No new matter has been added.

I. SECTION NO. 3: REJECTION UNDER 35 U.S.C. § 112

Claim 13 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. According to the examiner, there is insufficient antecedent basis for the recitation "unsaturated ester" in Claim 13.

In response, Applicant has amended Claim 11 to clarify that the transfer layer comprises a copolymer of ethylene and an unsaturated acid or an unsaturated ester. This was the intended scope for Claim 11, as originally filed. Withdrawal of the §112 rejection is requested.

II. SECTION NO. 5: REJECTION UNDER 35 U.S.C. § 102

Claims 1-14, 16-26, and 48-60 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,013,353 ("Touhsaent").

Applicant respectfully traverses.

Each of independent Claims 1 and 48 recites a transfer layer having a debonded surface and a metal-bonding surface.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Touhsaent does not anticipate under §102 either of Claims 1 and 48 at least for the reason that "a transfer layer having a debonded surface," as set forth in Claims 1 and 48, is not found, either expressly or inherently described, therein. Thus, the identical invention is not shown in as complete detail as is contained in the claim.

Specifically, the examiner asserts the following at page 3 of the Office Action"

> A polymeric low temperature sealable coating comprising an ethylene/ethylenically unsaturated carboxylic acid copolymer is deposited on the metal layer (abstract). ... Said low temperature sealable coating is herein understood to read on the claimed transfer layer, ...

However, the surface of Touhsaent's polymeric low temperature sealable coating which is opposite the coating's surface deposited on the metal layer has not been "debonded" such that it cannot be "a debonded surface" as presently claimed. A polymeric low temperature sealable coating having a debonded surface is not expressly described in Touhsaent, nor has there been identified any basis in fact and/or technical reasoning to reasonably support the determination that a polymeric low temperature sealable coating having a debonded surface necessarily flows from the teachings of Touhsaent.

For the foregoing reason, Applicant respectfully requests reconsideration and withdrawal of the §102 rejection.

III. SECTION NO. 7: REJECTION UNDER 35 U.S.C. § 103

Claim 15 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Touhsaent in view of U.S. Patent No. 5,492,741 ("Akao").

Applicant respectfully traverses.

Amended Claim 15 is independent, and it includes the recitation "a transfer layer having a debonded surface and a metal-bonding surface." Amended Claim 15 is patentable over the applied art because (i) Akao does not cure the deficiencies of Touhsaent noted above at Section II of this Amendment and (ii) neither Touhsaent nor Akao provides any motivation or suggestion to modify Touhsaent's polymeric low temperature sealable coating to have "a debonded surface."

In particular, the complete silence of both Touhsaent and Akao on the issue of a debonded surface prevents them from providing the "clear and particular" motivation which is a necessary part of any §103 rejection. In re Sang Su Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-1434 (Fed. Cir. 2002); Winner Int'l Royalty Corp. v. Ching-Rong Wang, 202 F.3d 1340, 1348-1349, 53 USPQ2d 1580, 1586-1587 (Fed. Cir. 2000).

For the foregoing reason, Applicant respectfully requests reconsideration and withdrawal of the §103 rejection.

IV. RESTRICTION AND ELECTION

On June 15, 2005, a written restriction requirement was issued and on July 15, 2005, Applicant made an election of Group I claims, with traverse, labeling the status of claims from both groups as "original." On September 9, 2005, the Examiner issued an Office Action and according to the Office Action Summary cover-page, section "4)", claims 27-47 are listed as "withdrawn," and according to section "6)", claims 1-26 and 48-60 are rejected. Applicant respectfully points out that the September 9 office action does not otherwise address whether or not Applicant's traversal was considered by the Examiner with a finding that the previous restriction requirement was improper or whether the restriction and provisional election was considered proper and made final (including the reasons therefore).

As such, Applicant respectfully contends that except for cancelled claim 30, all remaining claims are still actively pending in the case and should have the status of "original" or "amended." Applicant has provided herein the status of the claims accordingly.

Respectfully, Applicant repeats the provisional election of Group I, with traverse as set forth in Applicant's election and reply, filed on July 15, 2005 and, in the interest of brevity, reasserts the traversal set forth in the "Remarks" section of that July 15, 2005 document and includes the same herein by reference. Applicant respectfully reasserts that restriction is improper, at least on the basis that the products of the Group II claims are intermediate to the invention of the Group I claims. Applicant thanks the Examiner for reconsidering the restriction requirement.

V. CONCLUSION

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized to charge the required fee(s), or credit any overpayment, to Deposit Account No. 05-1712, in the name of ExxonMobil Chemical Company.

Respectfully submitted,

Date: February 9, 2006

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